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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,219	07/23/2001	Juha Rasanen	975.350USW1	4905

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EXAMINER
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GARY, ERIKA A

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/911,219

**Applicant(s)**

RASANEN, JUHA

**Examiner**

Charles N. Appiah

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-37 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-37 and 39-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 22-37 and 39-46 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Objections*

2. Claim 22 is objected to because of the following informalities: It appears on lines 15-16 of claim 22, "a first radio access network and a second radio access network" should be changed to **"said first radio access network and said second radio access network"** in order to provide proper antecedent basis for the radio access networks in the claim. Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 22-37 and 45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 22-37 and 45 recite functional descriptive steps, which are rendered intangible since it is implemented by the computer program embodied on a computer readable medium of claim 44 without any practical application and concrete result.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 22-38 and 39-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Lintulampi (6,37,804).

Regarding claims 22 39, 44 and 46 Lintulampi discloses a method of interworking between different radio access networks, a network interworking device and a computer program embodied on a computer readable medium, the method comprising: detecting a request for a specific service wherein the request for specific service is received from at least one of a first access network and a second access network (request for service being made by the first network, see col. 2, lines 21-24), accessing information on conditions for the first radio access network and the second access radio networks for giving sufficient support for a specific service requested by

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the request for specific and analyzing whether or not the first radio access network and second radio access network meet the conditions (GSM network analyzes the available resources for the service ..., see col. 4, lines 47-50, col. 5, line 64 to col. 6, line 8), initiating a handover of the radio transceiver device from the first radio access network to the second radio access network if the conditions are met by the second radio access network but the first radio access network does not (GSM network sends a handover request to the UMTS network, UMTS network accepts handover request, see col. 4, lines 50-60, col. 5, lines 45-57), wherein a radio transceiver capable of operating with the first radio access network and the second radio access network is attached to the first radio access network (MS 3 being registered with the GSM network, col. 3, lines 52-54).

Regarding claim 23, Lintulampi further discloses wherein the conditions comprise a condition whether the requested specific service exists in the radio access network (see col. 4, lines 44-50).

Regarding claim 24, Lintulampi further discloses wherein the conditions depend on each other (MS sending a service request to the GSM network and the request being rejected due to lack of resources and the UMTS network being selected to provide the service, see col. 5, line 43 to col. 6, line 8).

Regarding claim 25, Lintulampi further discloses wherein one of the conditions for the first radio access network is a given amount lower than the corresponding condition for the second radio access network (MS sending a service request to the GSM network and the request being rejected due to lack of resources

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and the UMTS network being selected to provide the service, see col. 5, line 43 to col. 6, line 8).

Regarding claims 26 and 40, Lintulampi further discloses wherein the method is performed in the radio transceiver device (application in MS sending a service request with quality of service parameter to the GSM network, see col. 5, lines 43-45).

Regarding claims 27 and 41, Lintulampi further discloses wherein the method is performed in a network control device (see col. 2, lines 21-32).

Regarding claim 28, Lintulampi further discloses informing the radio transceiver device of the fact that a handover to the second radio access network is to be initiated (MS being commanded to the UMTS network with handover command, see col. 4, lines 52-54).

Regarding claim 29, Lintulampi further discloses wherein the radio transceiver device is a dual mode phone which is adapted to be operated in the first radio access network and the second radio access network (see col. 3, lines 44-51).

Regarding claims 30-31 Lintulampi further discloses wherein either the first or second radio access radio network is a GSM network and a UMTS network (see col. 3, lines 44-51).

Regarding claims 32-33, Lintulampi further discloses wherein the requested specific service is a circuit-switched service and the requested specific service is a packet service (see col. 3, lines 10-15, col. 3, lines 44-49).

Regarding claims 36-37, Lintulampi further discloses wherein the radio transceiver device is attached to the first radio access network such that it is located in

a cell of the first radio access network and connected by air with the first radio access network and wherein the radio transceiver is also located in a cell of the second radio access network (see col. 3, lines 17-35).

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 34, 35 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi as applied to claims 22 and 39 above, and further in view of Tayloe et al. (5,826,188).

Regarding claims 34 and 35, Lintulampi fails to explicitly teach wherein an error procedure is initiated when it is detected in the analyzing that the requested specific service is not available in any of the networks, said error procedure being a notification of the user.

In an analogous field of endeavor, Tayloe discloses a method and apparatus for handing off calls between differing radio telecommunication networks wherein a determination is made as to whether a handoff is approved or not a handoff denial message is sent to a subscriber unit (see Fig. 3, col. 8, lines 20-28), which constitutes a notification of the user.

It would therefore have been obvious to one of ordinary skill in the art to combine Tayloe's inter-system handoff procedure with handoff denial message capability with Lintulampi's system in order to ensure the appropriate maintenance of desired

communication through handoff between multiple networks having different air interface standards as taught by Tayloe.

Regarding claim 42, Lintulampi fails to explicitly teach wherein the analyzing unit is connected to a database to obtain information regarding the conditions of the requested specific service.

Tayloe discloses wherein the analyzing means is connected to a database for obtaining information regarding the conditions of the requested service (see col. 7, lines 26-43, col. 11, lines 16-25).

It would therefore have been obvious to one of ordinary skill in the art to ensure the availability of special services based on stored subscriber profiles in the system of Lintulampi.

9. Claims 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lintulampi** as applied to claims 22 and 39 above and further in view of **Chambers (6,256,497)**.

Regarding claims 43 and 45 Lintulampi fail to explicitly teach wherein the analyzing means is configured to analyze whether a subscriber using the radio transceiver is entitled to use the requested service.

In an analogous field of endeavor, Chambers discloses a mobile telephone which is configured for dual-mode communication using an apparatus for interworking between first and second telecommunication networks, in which the first network provides a first telecommunication service and the second network provides a second telecommunications service (see col. 2, lines 41-51). According to Chambers in



response to a request, means are provided for determining from interworking data whether particular subscribers are permitted to use the second service provided by the second network (see col. 3, lines 4-14 and col. 9, lines 45-67). Chambers teaches that having access to different networks such as a satellite network allows subscribers such as roaming subscribers who move beyond coverage areas of their home PLMN to make use of unique services provided by the satellite network (see col. 2, lines 12-39).

It would therefore have been obvious to one of ordinary skill in the art to provide the interworking between different networks to provide services to subscribers of Chambers to Lintulampi in order to provide optional wide range services to subscribers irrespective of location.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kukkohovi (6,119,003) discloses a method and apparatus for performing automatic mode selection in a multi-mode mobile terminal.

Wild et al. (5,862,480) discloses a method for managing service accessibility between differing radio telecommunication networks.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CA

  
CHARLES APPIAH  
PRIMARY EXAMINER